

In the United States Patent and Trademark Office

Applicant: Kenichi YABUSAKI
Serial Number: 10/751,181
Confirmation No. 3401
For: Instrument and Method for Preparing Plug-Cut Bait
Docket Number: 03-YAB-117
Examiner: PARSLEY, DAVID J.
Art Unit: 3643

BRIEF ON APPEAL

Assistant Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia
22313-1450

Sir:

This is an appeal from the decision of the examiner dated February 28, 2007 finally rejecting claims 1- 30, in the above identified application.

(i) Real party in interest

The real party in interest is the inventor Dr. Kenichi Yabusaki.

(ii) Related Appeals and Interferences

Appellant and his legal representative are not aware of any appeals or interferences which will directly affect or be directly affected or have a bearing on the Board's decision in the pending appeal.

(iii) Status of the Claims

Claims Rejected: 1-30
Claims Allowed: NONE
Claims Cancelled: 16 – 21, 30
Claims Appealed: 1- 15, 22-29

(iv) Status of Amendments Filed Subsequent To Final Rejection

Amendment filed on June 24, 2007 – entered (cancels claim 30, and corrects Figure 1 and the specification as objected to by the examiner).

Amendment filed on Nov 26, 2007 – Pending consideration (cancels claims 16-21)

.

(v) Summary of Claimed Subject Matter

Claim 1 is an entrails removal instrument for making a hollow cavity in a body of a bait fish, comprising:

- a. an elongate section having two straight parallel longitudinal sides, said elongate section forming a curved groove through the entire length of the elongate section and through the centerline between said longitudinal sides; (See, page 5, lines 2 and 3 and **18,20, 22, and 26** on Figure 1)
- b. an end section, said end section extending from said elongate section and tapering gradually from the longitudinal sides to a rounded point such that the curved groove continues through the end section; and (See page 5, lines 5 to 10, and **24 and 28** on Figure 1)
- c. a plurality of tines emanating from a surface of the instrument, wherein at least one tine of said plurality of tines emanates from the end section and is directed away from the rounded point and towards the elongate section, wherein at least one tine of said plurality of tines emanates from a location away from said sides and away from said end section, wherein said entrails removal instrument has a width as measured between the longitudinal sides in the range between about one half inch and one inch and an overall length in the range between about five inches and about seven inches.(See page 5 lines 6 to 10, and lines 12 to 17 and **12,13,14, and 15** on Figure 1)

Claim 9 is a method of making a plug-cut bait from a bait fish having a head, body, and tail, the method including acts of:

- a) cutting the head off the bait fish with a knife while leaving the fish body and tail intact; (see page 6, lines 18 and 19, and **32**, **34**, and **38** on Figures 2A and 2B.)
- b) inserting an entrails removal instrument into the fish body to a position forward of the tail, wherein said entrails removal instrument comprises an elongate instrument body having two straight parallel longitudinal sides, said instrument body forming a curved groove between said longitudinal sides; an end section, said end section extending from said instrument body and tapering to a rounded point; and a plurality of tines emanating from a surface of the instrument, wherein at least one tine of said plurality of tines emanates from the end section and is directed away from the rounded point and towards the elongate body, wherein at least one tine of said plurality of tines emanates from a location away from said sides and away from the end section, wherein said entrails removal instrument has a width as measured between the longitudinal sides in the range between about one half inch and one inch and an overall length in the range between about five inches and about seven inches; (see page 6, lines 20-25 and **34**, **36**, and **39** on Figure 2C)
- c) rotating said entrails removal instrument;(page 6, lines 20-25) and removing the entrails removal instrument, whereby the viscera of the fish are removed leaving the body and tail intact with a neat hollow cavity (page 6, lines 20-25).

Claim 26 is an entrails removal instrument for making a hollow cavity in a body of a bait fish, comprising:

- a. an elongate section having two straight parallel longitudinal sides, said elongate section forming a curved groove through the centerline between said longitudinal sides, said sides comprising straight parallel longitudinal edges of said body;
(See, page 5, lines 2 and 3 and **18,20, 22**, and **26** on Figure 1)
- b. an end section, said end section extending from said elongate body and tapering gradually from the longitudinal sides to a rounded point, such that curved groove extends through the end section; (See page 5, lines 5 to 10, and **24** and **28** on Figure 1)
- c. a plurality of tines emanating from a surface of the instrument, wherein at least one tine of said plurality of tines emanates from the end section and is directed away from the rounded point and towards the elongate section, wherein said entrails removal instrument has a width as measured between the longitudinal edges in the range between about one half inch and one inch and an overall length in the range between about five inches and about seven inches.((See page 5 lines 6 to 10, and lines 12 to 17 and **12,13,14**, and **15** on Figure 1)

Claim 27 - A method of making a plug-cut bait from a bait fish having a head, body, and tail, the method including the acts of:

- a). cutting the head off the bait fish with a knife while leaving the fish body and tail intact; (see page 6, lines 18 and 19, and **32, 34**, and **38** on Figures 2A and 2B.)
- b). inserting an entrails removal instrument to a position forward of the tail, wherein the entrails removal instrument comprises an elongate instrument body having two straight parallel longitudinal sided, said instrument body forming a curved groove between said longitudinal sides, said sides comprising straight parallel longitudinal edges of said body; an end section extending from said instrument body and gradually tapering to a rounded point; and a plurality of tines emanating from a surface of the instrument, wherein at least one of said plurality of tines emanates from the end section and is directed away from the rounded

point and towards the elongate body, wherein said entrails removal instrument has a width as measured between the longitudinal edges in the range between about one half inch and one inch and an overall length in the range between about five inches and about seven inches; (see page 6, lines 20-25 and **34, 36, and 39** on Figure 2C)

c) rotating said entrails removal instrument; (page 6, lines 20-25). and

d) removing the entrails removal instrument, whereby the viscera of the fish are removed leaving the body and tail intact with a neat hollow cavity (page 6, lines 20-25).

(vi) Grounds of rejection to be reviewed on appeal.

1. Whether claims 1, 4 – 8, 22-23, 26,28, and 30 are patentable under 35 U.S.C 103(a) over U.S. Patent Application No. 2002/00002375 (Legeai) in view of U.S. 1,525,810 (Hill).

2. Whether claims 9-12, 14, 16, 19, 24, 25, and 27 are patentable under 35 U.S.C 103(a) over U.S. patent Application No. 2002/00002375 (Legeai) in view of U.S. 1,525,810 (Hill) and U.S. 4,704,769 (Hanechak).

3. Whether claim 3 is patentable over Legeai as modified by Hill in further view of U.S. 2,533,445 (Finney).

4. Whether claims 13, 15, 17-18 and 20-21 are patentable under 35 U.S.C 103(a) over Legeai in view Hill, Hanechak and further in view of U.S. 6,698,133 (Fricke).

5. Whether claims 2 and 29 are patentable under 35 U.S.C 103(a) over Legeai as modified by Hill and further U.S. 1,997,339 (Olson).

(vii) Arguments

Rejection of Claims 1, 4 – 8, 22-23, 26,28, and 30 under 35 U.S.C 103(a) over U.S. Patent Application No. 2002/00002375 (Legeai) in view of U.S. 1,525,810 (Hill).

The Applicant argues that the inclusion of U.S. 1,525,810 (Hill) as a reference in the 35 USC 103(a) rejection is improper because it is non-analogous art. "In order to rely on a

reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). Also, "where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved" *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003).

Hill fails on all three requirements; it is neither in the field of the applicant's endeavor, nor reasonably pertinent to the particular problem with which the inventor was concerned. It also does not disclose subject matter which is relevant to the particular problem with which the inventor is involved.

The instant invention is an entrails removal instrument for making a hollow cavity in a body of a bait fish to make plug cut bait,. including: an elongate body having two straight parallel longitudinal sides, said body forming a curved groove between said longitudinal sides; an end section, said end section extending from said elongate body and tapering in width to a rounded point; and a plurality of tines emanating from a surface of the instrument, wherein at least one tine of said plurality of tines emanates from the end section and is directed away from the rounded point and towards the elongate body, wherein said entrails removal instrument is adapted to fit into the body of the bait fish and form a hollow cavity when inserted into the body, rotated and removed.

Hill is a tool for use by transport workers or dock workers to replace the usual docker's hook when handling bag, bale or light case work. According to the invention a metal plate or stock studded on one, or its front surface, is provided with a series of short claw

like pins designed, when the said plate is laid with the said surface against the skin or cover of the bale, or the like to be handled, to engage or enter the said skin or cover to obtain a grip thereon, the said plate or stock being provided with a suitable handle for manipulative purposes.

Hill's dock workers' tool, for lifting a bail, is certainly not in the field of the applicant's endeavor, removing the entrails from a bait fish. Hill is also not reasonably pertinent to the particular problem with which the inventor was concerned. Hill is concerned with a dock worker lifting a bail while the instant invention is concerned with inserting the device into a bait fish and removing the entrails to make a cavity in the bait fish. Hill also does not disclose subject matter which is relevant to the particular problem with which the inventor is involved. Both Hill and the instant invention have tines (pins or claws), however their function is completely different. In Hill the claws are used to grab hold of the outer covering of a bag or bail. In the instant invention the tines are used to extract the entrails when the invention is inserted in the bait fish and then removed.

This case is very similar in principle to *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. Similarly a person of ordinary skill seeking to invent an entrails remover for making plug cut bait would not reasonably be expected or motivated to look to dock workers' tools for lifting a bail or bag.

Without Hill there is not a *prima facie* case of obviousness.

Rejection of claims 9-12, 14, 16, 19, 24, 25, and 27 under 35 U.S.C 103(a) over U.S. patent Application No. 2002/00002375 (Legeai) in view of U.S. 1,525,810 (Hill) and U.S. 4,704,769 (Hanechak).

The Applicant argues that the inclusion of U.S. 1,525,810 (Hill) as a reference in the 35 USC 103(a) rejection is improper because it is non-analogous art. The argument is exactly the same as that made *supra* for Claims 1, 4 – 8, 22-23, 26,28, and 30.

Rejection of claim 3 under 35 U.S.C 103(a) over Legeai as modified by Hill in further view of U.S. 2,533,445 (Finney)

The Applicant argues that the inclusion of U.S. 1,525,810 (Hill) as a reference in the 35 USC 103(a) rejection is improper because it is non-analogous art. The argument is exactly the same as that made *supra* for Claims 1, 4 – 8, 22-23, 26,28, and 30.

Rejection of claims 13, 15, 17-18 and 20-21 under 35 U.S.C 103(a) over Legeai in view Hill, Hanechak and further in view of U.S. 6,698,133 (Fricke).

The Applicant argues that the inclusion of U.S. 1,525,810 (Hill) as a reference in the 35 USC 103(a) rejection is improper because it is non-analogous art. The argument is exactly the same as that made *supra* for Claims 1, 4 – 8, 22-23, 26,28, and 30.

Rejection of claims 2 and 29 under 35 U.S.C 103(a) over Legeai as modified by Hill and further modified by U.S. 1,997,339 (Olson).

The Applicant argues that the inclusion of U.S. 1,525,810 (Hill) as a reference in the 35 USC 103(a) rejection is improper because it is non-analogous art. The argument is exactly the same as that made *supra* for Claims 1, 4 – 8, 22-23, 26,28, and 30.

Respectfully Submitted,
Foothill Law Group, LLP

Howard E. Lebowitz

Howard E. Lebowitz, Partner
19682 Hesperian Blvd., Suite 208
Hayward, CA 94541
510-785-8070
Reg. No. 44864

(viii) Claims Appendix

Claim 1 An entrails removal instrument for making a hollow cavity in a body of a bait fish, comprising:

- a. an elongate section having two straight parallel longitudinal sides, said elongate section forming a curved groove through the entire length of the elongate section and through the centerline between said longitudinal sides;
- b. an end section, said end section extending from said elongate section and tapering gradually from the longitudinal sides to a rounded point such that the curved groove continues through the end section; and
- c. a plurality of tines emanating from a surface of the instrument, wherein at least one tine of said plurality of tines emanates from the end section and is directed away from the rounded point and towards the elongate section, wherein at least one tine of said plurality of tines emanates from a location away from said sides and away from said end section, wherein said entrails removal instrument has a width as measured between the longitudinal sides in the range between about one half inch and one inch and an overall length in the range between about five inches and about seven inches.

Claim 2 The entrails removal instrument of claim 1, wherein said instrument is made from steel.

Claim 3 The entrails removal instrument of claim 1, wherein said instrument is made from stainless steel.

Claim 4 The entrails removal instrument of claim 1, wherein the at least one tine that emanates from the end section includes a plurality of tines.

Claim 5: The entrails removal instrument of claim 1, wherein the plurality of tines emanate from the surface of the instrument at an angle in the range between about 15 degrees and about 45 degrees.

Claim 6 The entrails removal instrument of claim 1, wherein the rounded point on the end section is honed to a blade.

Claim 7 The entrails removal instrument of claim 1, wherein the instrument is one integral piece.

Claim 8 The entrails removal instrument of claim 1, wherein the bait fish is a herring.

Claim 9 A method of making a plug-cut bait from a bait fish having a head, body, and tail, the method including acts of:

- a) cutting the head off the bait fish with a knife while leaving the fish body and tail intact;
- b) inserting an entrails removal instrument into the fish body to a position forward of the tail, wherein said entrails removal instrument comprises an elongate instrument body having two straight parallel longitudinal sides, said instrument body forming a curved groove between said longitudinal sides; an end section, said end section extending from said instrument body and tapering to a rounded point; and a plurality of tines emanating from a surface of the instrument, wherein at least one tine of said plurality of tines emanates from the end section and is directed away from the rounded point and towards the elongate body, wherein at least one tine of said plurality of tines emanates from a location away from said sides and away from the end section, wherein said entrails removal instrument has a width as measured between the longitudinal sides in the range between about one half inch and one inch and an overall length in the range between about five inches and about seven inches;
- c) rotating said entrails removal instrument; and
- d) removing the entrails removal instrument, whereby the viscera of the fish are removed leaving the body and tail intact with a neat hollow cavity.

Claim 10 The method of claim 9, wherein the entrails remover is inserted at least 2 inches into the fish body.

Claim 11 The method of claim 9, further including moving the entrails removal instrument in a lateral motion.

Claim 12 The method of claim 11, wherein the act of rotating includes rotating at least 360°.

Claim 13 The method of claim 12, wherein the method further comprises inserting at least one fishing hook attached to a fishing line into the hollow cavity and pushing it out through the fish body to form a bait.

Claim 14 The method of claim 9, wherein the bait fish is herring.

Claim 15 The method of claim 13, wherein the at least one fishing hook includes a plurality of fishing hooks.

Claim 22 The instrument of claim 1, wherein the groove comprises a substantially continuously curved groove.

Claim 23 The instrument of claim 1, wherein said sides comprise straight parallel longitudinal edges of said elongate section and wherein none of said plurality of tines emanate from said edges.

Claim 24 The method of claim 9 wherein said groove comprises a substantially continuous curved groove.

Claim 25 The method of claim 9, wherein said sides comprise straight parallel longitudinal edges of said elongate section and wherein none of said plurality of tines emanate from said edges.

Claim 26 An entrails removal instrument for making a hollow cavity in a body of a bait fish, comprising:

- a. an elongate section having two straight parallel longitudinal sides, said elongate section forming a curved groove through the centerline between said longitudinal sides, said sides comprising straight parallel longitudinal edges of said body;
- b. an end section, said end section extending from said elongate body and tapering gradually from the longitudinal sides to a rounded point, such that curved groove extends through the end section;
- c. a plurality of tines emanating from a surface of the instrument, wherein at least one tine of said plurality of tines emanates from the end section and is directed away from the rounded point and towards the elongate section, wherein said entrails removal instrument has a width as measured between the longitudinal edges in the range between about one half inch and one inch and an overall length in the range between about five inches and about seven inches.

Claim 27 A method of making a plug-cut bait from a bait fish having a head, body, and tail, the method including the acts of:

- a. cutting the head off the bait fish with a knife while leaving the fish body and tail intact;
- b. inserting an entrails removal instrument to a position forward of the tail, wherein the entrails removal instrument comprises an elongate instrument body having two straight parallel longitudinal sides, said instrument body forming a curved groove between said longitudinal sides, said sides comprising straight parallel longitudinal edges of said body; an end section extending from said instrument body and gradually tapering to a rounded point; and a plurality of tines emanating from a surface of the instrument, wherein at least one of said plurality of tines emanates from the end section and is directed away from the rounded point and towards the elongate body, wherein said entrails removal instrument has a width as measured between the longitudinal edges in the range between about one half inch and one inch and an overall length in the range between about five inches and about seven inches;
- c. rotating said entrails removal instrument; and
- d. removing the entrails removal instrument, whereby the viscera of the fish are removed leaving the body and tail intact with a neat hollow cavity.

Claim 28 The entrails removal instrument of claim 26, wherein all of the tines of said plurality of tines emanate from the end section.

Claim 29 The entrails removal instrument of claim 26, wherein said instrument comprises steel.

(ix) Evidence Appendix

NONE.

(x) Related Proceedings Appendix

NONE.